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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/025,947      | 12/26/2001  | Hsuan-Yin Lan-Hargest | 12938-003002        | 8464             |

26171 7590 03/14/2003

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EXAMINER

ZUCKER, PAUL A 19

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1621

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,947

Applicant(s)

LAN-HARGEST ET AL.

Examiner

Paul A. Zucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 6, 9-11, 14, 15, 18-21, 23, 24 and 27-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26 and 80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 December 2002 has been entered.

#### ***Election/Restrictions***

2. Applicant's election of 7,7-diphenyl-2, 4, 6-heptatrienoic acid for examination in Paper No. 6 is acknowledged. This specie reads on claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26 and 80. Examination has been limited to the elected specie and the claims readable thereon since no generic claim has been found allowable.

#### ***Current Status***

3. This action is responsive to Applicants' amendment of 6 March 2003 in Paper No 17.
4. The receipt and entry of Applicants' amendment is acknowledged.
5. Applicant's addition of new claim 80 is acknowledged.
6. Claims 1-80 are pending.
7. Claims 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 are held withdrawn from consideration.

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8. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26 and 80 are the subject of the following Office Action.
9. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 10 of the previous Office Action in Paper No 13 is withdrawn in response to Applicants' amendment.
10. The rejections under 35 USC § 103 set forth in paragraphs 11-13 of the previous Office Action in Paper No 13 are withdrawn in response to Applicants' amendment.

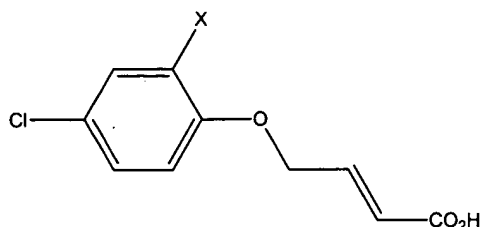
#### ***New Rejections***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

11. Claims 1-5, 12, 13, 16, 17, 22, 25 26 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan et al (WO 99/29640 A2 06-1999). Chan discloses (Page 117, lines 10-27, especially the listed compounds 8,9, 11 and 17-23) large number of 11-(substituted phenyl) - undecanoic acids. Chan further discloses (Page 94, lines 5-18, for example) their synthesis. Chan further discloses (Page 49, line 24- Page 51, line 26). Claims 1-5, 12, 13, 16, 17, 22, 25 26 and 80 are therefore anticipated by Chan.
12. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadohara et al (JP 53-101527 A2 09-1978). Sadohara discloses (Abstract, lines 1-3) the phenoxycrotonates I:

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where X= Cl or Me. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25 and 26 are therefore anticipated by Sadohara.

13. **EXAMINER'S NOTE:** Applicants are reminded to cancel claims 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 in their response to this Office Action. The cancellation of claims 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 was apparently inadvertently omitted by Applicants in their response to the previous Office Action in Paper No 13.

### **Conclusion**

14. Claims 1-80 are pending. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26 and 80 are rejected. Claims 6, 9-11, 14, 15, 18-21, 23, 24 and 27 -79 are held withdrawn from consideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are


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703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker  
Patent Examiner  
Technology Center 1600

March 13, 2003

  
Johann Richter, Ph.D., Esq.  
Supervisory Patent Examiner  
Technology Center 1600